



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,220	01/31/2005	Oscar Julian Sanchez Ferreras	P/189-329	1822
2352	7590	01/26/2006	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			KIM, WESLEY LEO	
			ART UNIT	PAPER NUMBER
			2688	

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/502,220	SANCHEZ FERRERAS ET AL.	
	Examiner	Art Unit	
	Wesley L. Kim	2688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is in response to Amendment filed on 11/14/05.

- Claim 1 is cancelled.
- Claims 2-14 are currently amended.
- Claim 15 is newly added.

Claims 2-15 are pending in the current office action. This action is made FINAL.

Response to Arguments

Applicant's arguments with respect to claim 2-15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 2 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The examiner notes that the newly added claim 15 and Claim 2 has been amended to include new subject matter not previously disclosed in the claims nor is the newly added subject matter disclosed in the specification. The terms "special

services" in Claim 15 line 2, "a special service module" in Claim 15 line 15 and line 28, and "contracted special services" in Claim 15 line 29 are newly added subject matter not supported by the specification. The examiner notes the specification teaches of services and a plurality of service modules, however there is no teaching of any special module or special services. The examiner asks the question, "Where in the specification is a *special* module or a *special* service taught?"

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "special" in claims 2 and 15 is relative term which renders the claim indefinite. The term "special" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The examiner notes the specification teaches of services and a plurality of service modules, however there is no teaching of any *special* module or *special* services. The examiner asks the question, "What is meant by special?"

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 2688

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3, 8, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joss et al (U.S. Patent 6684073 B1) in view of McCombe (GB 2280085 A) and McCann et al (U.S. Pub. 2001/0029182 A1).

Regarding Claim 15, Joss teaches a system for tracking mobile telephone subscriber units (Col.2;14-16, the HLR keeps track of location of roaming subscribers) to permit provision of special services to a subscriber traveling between a home network and a foreign network (Col.1;44-48, forwarding calls to a mobile terminal is a special service) and for storing information indicative thereof (Col.2;14-16, info stored in HLR), the home network and the foreign network interconnected through a gateway (Fig.1;3 and Col.5;14-16, i.e. conversion device), said gateway (Fig.1;3, conversion device, i.e. gateway) being arranged to provide communication with the mobile subscriber accessing the respective foreign network and to provide, as part of the normal operation of the networks, for the transmission of signaling parameters between the foreign network and the home network (Col.7;26-34, converts data from one network into the appropriate protocol data units so the data may be forwarded to another network), said signaling parameters including an indication of mobile subscribers entering and exiting the foreign network (Col.2;4-16, the HLR keeps track of location of roaming subscribers, i.e. entering and exiting the foreign network), as well as data regarding the foreign network and data regarding the mobile subscriber (Col.2;1-16, data stored in the VLR, i.e. foreign network, is sent to the

IMSI identifying a subscriber is data regarding the mobile subscriber), the home network including a first data storage unit operative to store an indication that said mobile subscriber is in the foreign network in response to said signaling parameters (Col.2:4-16, HLR stores information); wherein the system comprises: a data processing unit connected between the gateway and the home network (Fig.1:4, HLR has a CPU), a data analysis unit coupled to the data processing unit (Fig.1:4, inherent CPU has software for analyzing); said data processing unit being operative to detect, on the basis of information circulating through the gateway (Col.7:26-34, conversion module, i.e. gateway, permits information to go from one network to another), the signaling parameters including the indication of entrance and exit of the one or more mobile subscribers in and from the respective foreign network (Col.2:4-16, the HLR keeps track of location of roaming subscribers, i.e. entering and exiting the foreign network), the data regarding the foreign network and the data regarding the mobile subscriber (Col.2:1-16, data stored in the VLR, i.e. foreign network, is sent to the HLR, and IMSI identifying a subscriber is data regarding the mobile subscriber), the data processing unit further being operative to separate and send the detected signaling parameter data to the data analysis unit (Col.1:44-48 and Fig.1:4, inherent CPU sends data to software for analyzing), the data analysis unit being operative to identify subscribers of the associated home network entering and exiting a foreign network (Col.2:4-16, the HLR keeps track of location of roaming subscribers, i.e. entering and exiting the foreign network), and to generate

identifying data regarding the foreign network and the mobile subscribers in the foreign network (Col.2;14-16, information about location of subscriber and visited network stored so it has to have been generated), however the combination is **silent on** the home network and the foreign network being part of a plurality of mobile telephone networks, a second data storage unit coupled to the data processing unit; and a special service module, and the data analysis unit being further operative to provide the identifying data generated thereby to the second data storage unit, the second data storage unit being operative to store the identifying data, the special service module being responsive to the identifying data stored in the second data storage unit to provide contracted special services to the mobile subscribers in the foreign networks.

McCombe teaches the foreign network being one of a plurality of foreign networks (Pg.10;4-10, A, B, C) and McCombe further teaches the system being arranged to provide contracted special services to the mobile subscribers in the foreign networks (Pg.19;9-11, setting up a communications link is a special service which allows a person to communicate with another person wirelessly).

McCann teaches that it is well known in the art to have a second HLR, i.e. data storage unit, coupled to a first HLR, i.e. data processing unit (Fig.8;116) and McCann further teaches that data may be stored in either the first or second data storage unit (Par.13; 1-6, data can be stored in the first or second HLR).

McCombe teaches that an MSC, i.e. special service module, is responsive to identifying the data stored in an HLR to provide contracted special services to

the mobile subscribers in the foreign networks (Pg.14;19-26, processing calls and charging for calls made are special services).

To one of ordinary skill in the art it would have been obvious to modify, Joss such that the home network and the foreign network being part of a plurality of mobile telephone networks, a second data storage unit coupled to the data processing unit; and a special service module, and the data analysis unit being further operative to provide the identifying data generated thereby to the second data storage unit, the second data storage unit being operative to store the identifying data, the special service module being responsive to the identifying data stored in the second data storage unit to provide contracted special services to the mobile subscribers in the foreign networks, to provide a method where calls can be made to and from a subscriber and are billed to the subscriber regardless of whether they are in their home network or in a foreign network.

Regarding Claim 3 and 8, the combination as taught above teaches all the limitations as recited in claim 1 and claim 2, respectively, however the combination **is silent on** an event-based service module (9) connected to an event generator (11) and arranged so that when the event generator (11) generates a service for subscribers located in foreign networks, the event-based service module (9) accesses the storage means (7) to obtain the information on which subscribers are located in foreign networks (3).

Joss teaches that calls are forwarded to the respective mobile phone in the respective foreign network (Col.1;44-48). To the examiner this reads on the

claim, since one of ordinary skill in the art would find it obvious that the CPU within the HLR will access from the HLR storage (i.e. access data from the storage) means the information necessary to forward the call (i.e. generate a service) to the appropriate mobile phone and appropriate foreign network. It is obvious that there exists some sort of event generator and event based module for accessing data from the storage means and for generating a service.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Joss, such that an event-based service module (9) is connected to an event generator (11) and arranged so that when the event generator (11) generates a service for subscribers located in foreign networks, the event-based service module (9) accesses the storage means (7) to obtain the information on which subscribers are located in foreign networks (3), to provide services to said subscribers in the foreign network.

4. Claim 2, 5-7, 9, 10, 12-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Joss et al (U.S. Patent 6684073 B1), McCombe (GB 2280085 A), and McCann et al (U.S. Pub. 2001/0029182 A1) in further view of Nilsson (WO 01/10109 A2).

Regarding Claim 2, Joss, McCombe, and McCann teach all the limitations as recited in claim 1, however the combination **is silent on** wherein the analysis means (6) are connected to a real time service module (8) and arranged to inform said real time service module (8) every time the analysis means detect an entrance/exit of a subscriber in a foreign network, in order to make it possible for

the real time service module (8) to immediately provide real time services to the subscribers in a foreign network.

Nilsson teaches that a MAP protocol enables real time transfer of charging related information (Pg.6;7-9) and Joss teaches that the Home network (which was taught to have an Analysis means in the rejection of claim 1) has a MAP-PDU-H2 data unit (Col.10;23-26 and Fig.2, i.e. real-time module) connected to it.

Nilsson further teaches that it is possible to monitor the charging related activities of roaming subscribers (Col.6;10-11). To one of ordinary skill in the art it is obvious that the analysis means must inform the real time service module every time it detects an entrance/exit of a subscriber in a foreign network to monitor charging related activities in real time.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Joss, McCombe, and McCann, such that the analysis means (6) are connected to a real time service module (8) and arranged to inform said real time service module (8) every time the analysis means detect an entrance/exit of a subscriber in a foreign network, in order to make it possible for the real time service module (8) to immediately provide real time services to the subscribers in a foreign network, to provide a method of keeping track of the location of users and reducing the chance of fraud by roaming subscribers.

Regarding Claim 5, the combination as discussed above teach all the limitations as recited in claim 2, however the combination **is silent on** upon detecting an entrance of a subscriber into a foreign network, said analysis means

consider that the subscriber has entered into a foreign network, storing this information in the storage means (7), updating the current subscriber location and communicating this to the real time service module (8).

Nilsson teaches the HLR maintains a record of all the subscribers all the home network (Pg.2:22-24) and the HLR sending a subscriber update message to the VLR (Pg.5:16-18). To the examiner it is obvious that the entrance of the subscriber is detected by the analysis means upon registration of the terminal (Pg.5:4-14) and this information must be communicated to the real time service module in order to provide real time services (Pg.2:11-13 and Pg.6:8-9).

Regarding Claim 6, the combination as discussed above teach all the limitations as recited in claim 2, however the combination is **silent on the** analysis means (6) are arranged so that when said analysis means detect an exit of a subscriber from a foreign network (3), the analysis means (6) verify whether notification has been received that the subscriber has entered into another foreign network (3), the analysis means further being arranged so that: if the result of the verification is affirmative, the analysis means consider that the subscriber has entered into another foreign network, storing this information and updating the current subscriber location in the storage means (7), and communicating this to the real time service module (8); whereas if the result of the verification is negative, the analysis means consult the home network (1) to verify whether the subscriber has again entered the home network, and if an

affirmative response is obtained, the analysis means eliminate the corresponding entry in the storage means (7) and report this to the real time service module.

Nilsson teaches that an HLR maintains a record of all the subscribers of the home network (Pg.4, i.e. directory number, current location, profile information) and to one of ordinary skill in the art, it is obvious that if a subscriber roams out of the home region then the HLR's analysis means (i.e. CPU) determines if a subscriber has roamed into a foreign network. If a subscriber has roamed into a foreign network the analysis means will receive an affirmation from the VLR of the visited system however if the subscriber cannot be found (i.e. the subscriber got on a plane and turned off the phone) the analysis means will receive no affirmation (i.e. a negative verification) so therefore the HLR will check all possible locations where the phone may be, (i.e. home network). If the user is found the HLR will update its records (Pg.5:4-22) to keep an accurate record of all the subscribers of the home network (Pg.4:21-24).

Regarding Claims 7, 10, and 14, Joss, McCombe, and McCann teach all the limitations as recited in claim 1, claim 3, and claim 8, respectively, however the combination **is silent on** wherein the storage means (7) are arranged to store a log of all the visits made by each subscriber to the foreign networks so as to permit consultation thereof by other systems.

Nilsson teaches an HLR maintaining a record of all subscribers of the home network (Pg.4:22-24). It is obvious that a log of a subscriber in a foreign network is kept.

McCombe teaches one HLR accessing subscriber information from another HLR (Pg.14;19-24) so it is obvious that the storage means containing a log of visits made by each subscriber to the foreign network is consulted by other systems.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Joss, McCombe, and McCann, such that storage means (7) are arranged to store a log of all the visits made by each subscriber to the foreign networks so as to permit consultation thereof by other systems, to provide a method of accessing information that is already available to processing calls more quickly.

Regarding **Claims 9, 12, and 13**, Joss, McCombe, McCann and Nilsson teach all the limitations as recited in claim 2, claim 5 and claim 6, and Nilsson further teaches an HLR maintaining a record of all subscribers of the home network (Pg.4;22-24). It is obvious that a log of subscribers in foreign networks are kept, however the combination **is silent on** wherein the storage means (7) are arranged to store a log of all the visits made by each subscriber to the foreign networks so as to permit consultation thereof by other systems.

Nilsson teaches McCombe teaches one HLR accessing subscriber information from another HLR (Pg.14;19-24) so it is obvious that the storage means containing a log of visits made by each subscriber to the foreign network is consulted by other systems.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Joss, McCombe, and Nilsson, such that storage means (7) are arranged to store a log of all the visits made by each subscriber to the foreign networks so as to permit consultation thereof by other systems, to provide a method of accessing information that is already available to processing calls more quickly.

1. Claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Joss et al (U.S. Patent 6684073 B1), McCombe (GB 2280085 A), and McCann et al (U.S. Pub. 2001/0029182 A1) in further view of Yamaguchi et al (U.S. Patent 6002931).

Regarding Claim 4, Joss, McCombe, and McCann teach all the limitations as recited in claim 1, however the combination **is silent on** the storage means (7) are arranged to contain data regarding features of each foreign network (3), in order to make it possible for the system to determine which network different received data belong to, and to adapt the contracted services to the features of the foreign network in which the subscriber is located.

Yamaguchi teaches an HLR of a home network keeping a database record for network identities of visited networks (Col.1;44-48) and Yamaguchi further teaches retrieving data of the visited network and establishing a traffic channel in accordance with the results (Col.1;64-Col.2;5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Joss, McCombe, and McCann, such that the storage means (7) are arranged to contain data regarding features of each foreign

network (3), in order to make it possible for the system to determine which network different received data belong to, and to adapt the contracted services to the features of the foreign network in which the subscriber is located, to provide a method of successfully providing the appropriate services for subscribers roaming in different networks.

2. Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Joss et al (U.S. Patent 6684073 B1), McCombe (GB 2280085 A), McCann et al (U.S. Pub. 2001/0029182 A1), and Yamaguchi et al (U.S. Patent 6002931) in further view of Nilsson (WO 01/10109 A2).

Regarding Claim 11, Joss, McCombe, McCann, and Yamaguchi teach all the limitations as recited in claim 4, however the combination **is silent on** wherein the storage means (7) are arranged to store a log of all the visits made by each subscriber to the foreign networks so as to permit consultation thereof by other systems.

Nilsson teaches an HLR maintaining a record of all subscribers of the home network (Pg.4;22-24). It is obvious that a log of a subscriber in a foreign network is kept.

McCombe teaches one HLR accessing subscriber information from another HLR (Pg.14;19-24) so it is obvious that the storage means containing a log of visits made by each subscriber to the foreign network is consulted by other systems.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Joss, McCombe, and Yamaguchi such that storage means (7) are arranged to store a log of all the visits made by each subscriber to the foreign networks so as to permit consultation thereof by other systems, to provide a method of accessing information that is already available to processing calls more quickly.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2688

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley L. Kim whose telephone number is 571-272-7867. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WLK

A handwritten signature in black ink, appearing to read "George Eng".

GEORGE ENG
SUPERVISORY PATENT EXAMINER